

REMARKS

In response to the Office Action mailed May 1, 2008, the Examiner's claim rejections have been considered. Applicants respectfully traverse all rejections regarding all pending claims and earnestly solicit allowance of these claims.

1. Claim Rejections – 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 153-156, 158-166 and 168-171 under 35 USC §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

The Examiner states that Applicants' specification does not teach "the promotional award having no cash or game credit value." It is respectfully submitted that this negative limitation is taught by the current specification. As M.P.E.P. § 2173.05(i) states, "if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ('[the] specification, having described the whole, necessarily described the part remaining.')

There are several embodiments of promotional awards described in the current specification, and at least the following examples taken from the current specification teach that the described promotional awards have no cash or game credit value.

In the current specification at page 13, lines 9-11, the promotional award may be "very particularized forms of enhanced game play, enhanced game award levels, and enhanced general award levels." These enhanced features of the primary game are not cash and they have no game credit value. Also, these enhanced features are given to the player as a promotional award and are not purchased with cash or game credits. Page 14, lines 14-15 of the current specification describes award credits that are "unlike game credits which are used for playing the game 100, may be directly redeemed for prizes or awards on prize station 112." Thus, award credits in this embodiment are used to redeem prizes, and are not used as cash or game credits. Also, at page 18, lines 18-21, the current specification states that "the prizes are not generally redeemable directly via cash payments by the player," but rather "the prizes are normally redeemable via award credits earned by the player from playing gaming device." Hence, the award credits in

this embodiment have no cash value, but can be used to redeem prizes. Therefore, Applicants respectfully submit that a person of ordinary skill in the art would find that the current specification does teach “promotional award having no cash or game credit value,” and request that the 35 USC §112 rejection of the claims be withdrawn.

2. Claim Rejections – 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 153-156, 158-166 and 167-171 under 35 USC §112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse this rejection.

The Examiner states that it is not clear how the promotional award is determined to be applicable if they have no game credit value, and that it must have some kind of game enhanced credit value to keep track on how much promotional award a player has. The claims of the current application recite a promotional award (claim 153) or promotional data (claim 162) having no cash or game credit value that are configured to add one or more game features to the game. As described in section 1 of this paper, in certain embodiments, the promotional award is an enhanced gaming feature as described at page 13, lines 9-11 of the current specification, which is given to a player as a promotional award. Embodiments of the enhanced game features are described at least at page 55, line 4 through page 56 line 8 of the current specification. This section of the specification states that the enhanced game features may involve invoking additional winning indicia, additional paylines, and a secondary game. Therefore, the current specification describes the applicability and use of the promotional awards in such a way to enable a person of ordinary skill in the art to make and/or use the invention. Applicants respectfully submit that the claims conform to all applicable requirements under 35 USC §112 and respectfully request that the rejections be withdrawn.

3. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 153-155, 158-165 and 168-171 under 35 U.S.C. § 103(a) as being unpatentable over Walker (U.S. Patent No. 6,227,972) in view of Crouch (U.S. Patent No. 5,580,053). Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Walker and Crouch references do not render the claimed invention obvious because these references fail to disclose all of the claimed limitations. Independent claims 153 and 162 each recite receiving a promotional award that has “no cash or game credit value.” The Examiner clearly admits on page 5 of the Office action that neither Walker nor Crouch teach the promotional award having no cash or game credit value. Therefore, this limitation of the claims is missing in the cited references.

The claimed invention also recites that the promotional award (having no cash or game credit value) adds additional pay lines, additional winning indicia, or a secondary game trigger to a base game. However, Walker discloses that promotional award can be used as game credits for a gaming machine. Crouch discloses a slot machine in which additional pay lines are added to the game for additional credits. Modifying Walker’s method of using promotional awards as game credits to purchase additional pay lines as taught by Crouch still does not teach all the claim limitations of the current claims, because neither reference teaches receiving a promotional award configured to add one or more game features, where the promotional awards have no cash or game credit value. Therefore, claims 153 and 162, and those claims that depend therefrom, are allowable over the cited references.

4. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 156 and 166 under 35 U.S.C. § 103(a) as being unpatentable over Walker (U.S. Patent No. 6,227,972) in view of Crouch (U.S. Patent No. 5,580,053) as applied to claims 153 and 162 above, and further in view of Walker (U.S. Patent No. 6,364,765) (“Walker ‘765”).

Applicants note that claims 156 and 166 are dependent claims that depend from independent claims 153 and 162, respectively. In light of the arguments submitted in Section 1, 2 and 3 of this response, Applicants respectfully submit that dependent claims 156 and 166 are not obvious in view of the combination of Walker, Crouch, and Walker ‘765 because these references, alone or in combination, fail to teach or suggest all the claimed limitations. Moreover, these dependent claims further recite and define the claimed invention, and thus, are

independently patentable. In conclusion, Applicants respectfully submit that the 35 U.S.C. §103(a) rejection of claims 156 and 166 have been overcome.

CONCLUSION

Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of claims 153-156, 158-166 and 168-171 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name STEPTOE & JOHNSON LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 734-3200. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

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